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10/564,610

01/12/2006

Glenn Gordon

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

06/10/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/564,610 | <b>Applicant(s)</b><br>GORDON ET AL. |  |
|                              | <b>Examiner</b><br>MARC S. ZIMMER    | <b>Art Unit</b><br>1796              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 14-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 4, 10-13, 17, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/12/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-6, 8, and 14-15 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 4-5, and 7 of copending Application No. 10/564611 (hereinafter ‘611). This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

In consideration of whether or not the present claims should be deemed patentably indistinct over those of co-pending application ‘611, the Examiner views the

matter with an eye to restriction practice. That is to say, the Examiner pondered the question of, had they been presented in the same application, could they be restricted? The only appropriate relationship between these claims were the Examiner to attempt to rationalize restriction would have been combination/subcombination. This is a two-way test wherein one of the considerations is whether or not the combination (the composition of the co-pending claims) would rely on the particulars of the subcombination (the instantly claimed copolymer) for its patentability. The Examiner believes that it would because acrylic compounds and isocyanate compounds are certainly well known materials. In this sense, the combination and subcombination are not patentably distinct and the above-stated rejection is justified.

Another perhaps slightly less tenable line of reasoning would be that the "resin" claim might plausibly be treated as a composition claim wherein the only required component is the resin itself. Indeed, the skilled artisan would immediately recognize that there is an extremely small probability that the copolymer would have any commercial utility without adding any other polymer material, inorganic filler, organic- or inorganic adjuvant, etc. Therefore, a defensible treatment of the claim would be to read it as having the same scope as a claim reciting, "A composition comprising a resin..." Of course, the transitional phrase "comprising" is open-ended thereby indicating that other materials may be incorporated and the scope of the claim would embrace the composition of the '611 application.

In any case, the Examiner could not provide an equally suitable rationale for withholding rejection.

Claims 1-3, 5-9, 14-16, and 18 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 4-5, 7, 19, and 23 of copending Application No. 10/564,612 (hereinafter '611). This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

The Examiner believes that a similar rationale to that outlined with respect to the patentability of the claims over the '611 application applies here also. That is to say, it does appear to be true that the patentability of the co-pending claims hinges, at least in part, on the novelty of the amino-functional polysiloxane resin component.

The claimed invention is, in the Examiner's estimation, allowable over prior art. U.S Patent Nos. 5,135,993, 5,262,507, and several other patents that had evolved from divisional applications of these (at least some of which are furnished in Applicants' IDS) represent the closest prior art in that they teach amino-functional silicone resins that share many of the same structural attributes as are presently claimed. However, the resins are different at least in that they are devoid of the "M units" that are required of the claimed resin. *The Examiner takes note of the fact that, in disclosing the claimed polymer, the subscript "a" is described as having a value of less than 0.4 which the Examiner appreciates may include zero. However, the language seems to explicitly*

Art Unit: 1796

*require the presence of units adhering to formula (i) thus it has been presumed for the purpose of evaluating the claims against the prior art that "a" actually has some non-zero value that is less than 0.4. Should Applicant take issue with this interpretation of the claims, they are advised that a rejection over one or more of the aforementioned references would almost certainly follow.*

***Allowable Subject Matter***

Claims 4, 10-13, 17, and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 4, 2008

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796